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| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/824,797                      | 04/15/2004  | Masayuki Satake      | UNIU79.023AUS       | 6655             |
| 20995                           | 7590        | 05/05/2006           |                     |                  |
| KNOBBE MARTENS OLSON & BEAR LLP |             |                      |                     |                  |
| 2040 MAIN STREET                |             |                      |                     |                  |
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|                                 |             |                      | EXAMINER            |                  |
|                                 |             |                      | HON, SOW FUN        |                  |
|                                 |             |                      | ART UNIT            | PAPER NUMBER     |
|                                 |             |                      | 1772                |                  |

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/824,797

Applicant(s)

SATAKE ET AL.

Examiner

Sow-Fun Hon

Art Unit

1772

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment to advisory action. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 1-17.  
Claim(s) withdrawn from consideration: None.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: Attachment to advisory action.

***Advisory Action***

1. The newly proposed amendment has not been entered because it changes the scope of independent claim 1, and hence the scope of the dependent claims, presenting new issues, requiring the present grounds of rejections to be withdrawn, and new ones to be presented. Furthermore, the newly proposed amendment and Applicant's arguments do not place the application in condition for allowance for the reasons set forth below.

2. Applicant argues that Hara does not disclose polyaniline, which is either water soluble or water dispersible, since not all polyanilines are water soluble or water dispersible, citing Hara as stating that the polyanilines are part of "various doped materials obtained by subjecting these polymers to an ion-doping procedure".

Applicant is respectfully apprised that while Applicant has defined the term "water soluble polymer" as having a solubility of 5 g or greater in 100 g water, Applicant has not defined the term "water dispersible polymer" except in naming polyaniline and polythiophene as water dispersible or water soluble conductive polymers. The statement by Hara that the polyaniline can be ion-doped implies that the polymer has some inherent dissociating mechanism in order to be ion-doped. Dissociation into ions implies some form of water dispersibility, at the very least. Furthermore, Applicant has not demonstrated that the polyaniline of Hara is not water soluble, as defined by Applicant.

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3. Applicant argues that similarly, Mukunoki fails to disclose that the polyanilines and polythiophenes are water soluble or water miscible, and thus does not disclose a water soluble or a water dispersive polymer.

Applicant is respectfully reminded that while Applicant has defined the term "water soluble polymer" as having a solubility of 5 g or greater in 100 g water, Applicant has not defined the term "water dispersible polymer" except in naming polyaniline and polythiophene as water dispersible or water soluble conductive polymers. Furthermore, Mukunoki teaches that the polyaniline derivatives and polythiophene derivatives are ionic polymers which have dissociating groups (column 12, lines 46-53), implying that these polyanilines and polythiophenes may even be water soluble as defined by Applicant. Applicant has not demonstrated that the polyaniline derivatives and polythiophene derivatives of Mukunoki are not water soluble, as defined by Applicant.

4. Applicant's arguments against the secondary references are based both on the arguments against Hara or Mukunoki as valid primary references, which have been addressed above; and/or directed towards the newly proposed amendment which has not been entered, and are therefore not addressed in this advisory action.

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Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*S. Hon*

Sow-Fun Hon

04/27/06

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 4/27/06